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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,293	12/06/2001	Thomas Bierbaum	66489-012-4	5081
25269	7590	12/29/2004		
DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005			EXAMINER BUMGARNER, MELBA N	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/003,293	Applicant(s) BIERBAUM ET AL.	
	Examiner Melba Bumgarner	Art Unit 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 2,5-9 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10-14,18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elements of a drive motor with a connection point provided on the motor, the connection point corresponds to the connection point of a tool, a drive tool on the elected species must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The replacement drawings submitted July 23, 2004 are not acceptable as they contain new matter. In figure 15, described as an isometric view of a neck drive

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including a root canal treatment tool, the exterior view of the neck drive of figure 15 does not appear to be that of the claimed invention presented in this application. In figure 3, the replacement figure does not adequately showing the claimed features, and the changes are not supported by the specification as to the location of the drive motor; i.e., the drive motor has been placed on the opposite side of the clutch from the drive part.

### *Specification*

3. The disclosure is objected to because its contents appear to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors. Applicant has noted that the translated has been translated fro placement in proper English format; however, numerous errors can still be noted. Following are a few examples: page 12 “which is necessary for the rotation of the treatment tool increased,” page 2, “extremely high strains of the tool are used,” page 11, “the admitted torques of the treatment tool,” page 10, “[a]s the reduction amplifies in a corresponding manner, the torque on the output side, the torque threshold, can be made by means of the magnetic clutch with the clutch parts.” Applicant is request to review the entire specification and make the appropriate corrections.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe the drive motor and connection point for a tool located on the side of the neck opposite the drive part.

6. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe how the drive motor and connection point for a tool enables the instrument to utilize the reduction gear and magnetic clutch.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant is reminded that the structure, which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. In claims 10, 11, and 13, it is unclear that “the magnetic clutch element” has been claimed to be further limited.

#### *Claim Objections*

9. Claims 4 and 12 are objected to because of the following informalities: “one or more clutch elements” should read –the at least one magnetic and/or magnetizable clutch element—in claim 4 and correct “a rotation speeds” in claim 12. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, 4, 10, 11, 13, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ciolli (5,135,086). Ciolli discloses an instrument 10 having a transmission device with at least one magnetic and/or magnetizable clutch element 120, the clutch element having an air gap, the instrument comprising a means for influencing the transmission torque of the magnetic and/or magnetizable clutch element 140 by modifying the magnetic flux of the clutch element. Patentable weight is not given to the intended use of the instrument. The means of influencing is made of a magnetically conductive material in the form of a sleeve 144,142. The sleeve is positioned in a zone of influence. Switching means is provided that cooperate with the means for influencing and in turn the clutch element (column 3 line 60). The clutch assembly has the capability to enable a tool to be moved in an opposite direction to an original working direction by means of a force created in the opposite direction after declutching of the element (column 7 line 5). A drive tool having a threshold value, the transmission device is formed such that the threshold value is not reached (column 6 line 55).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciolli. Ciolli discloses an instrument that shows the limitations as described above further including a drive motor 14 and a reduction gear 42; however, Ciolli does not show the specific range of reduction in speed of between 5 and 25 rotations/sec. It would have been an obvious matter of choice to one having ordinary skill in the art at the time the invention was made as to the specific range of reduction in speed. The specific range is not disclosed as critical to the claimed invention. It would have been an obvious matter of choice to one of ordinary skill in the art as to the specific tool claimed in addition to the instrument. The tool is not disclosed as critical to the claimed invention.

#### ***Response to Arguments***

14. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 703-305-0740. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Melba Bumgarner".

Melba Bumgarner  
Patent Examiner